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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,757	05/20/2004	Gregory P. Wittenberg	1321.010	7357
23598 BOYLE FRED	7590 08/24/2007 PRICKSON S.C.	EXAMINER		
840 North Plankinton Avenue			TRUONG, KEVIN THAO	
MILWAUKEE, WI 53203			ART UNIT	PAPER NUMBER
			3734	
•				****
			NOTIFICATION DATE	DELIVERY MODE
			08/24/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

			-				
		Application No.	Applicant(s)				
Office Action Summary		10/849,757	WITTENBERG, G	WITTENBERG, GREGORY P.			
		Examiner	Art Unit				
		Kevin T. Truong	3734				
The Period for Rep	The MAILING DATE of this communication appears on the cover sheet with the correspondence address						
A SHORTE WHICHEVE - Extensions or after SIX (6) - If NO period to - Failure to rep Any reply rec	ENED STATUTORY PERIOD FOR REPER IS LONGER, FROM THE MAILING If time may be available under the provisions of 37 CFR 1 MONTHS from the mailing date of this communication. For reply is specified above, the maximum statutory period ly within the set or extended period for reply will, by statueived by the Office later than three months after the mail term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMU. .136(a). In no event, however, made will apply and will expire SIX (6) lete, cause the application to become	INICATION. y a reply be timely filed MONTHS from the mailing date of this c e ABANDONED (35 U.S.C. § 133).				
Status							
1)☐ Resp	onsive to communication(s) filed on	·					
, 	This action is FINAL . 2b) ☐ This action is non-final.						
•	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
close	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of	Claims						
4)⊠ Clain	n(s) <u>1-21</u> is/are pending in the applicatio	n.					
•	4a) Of the above claim(s) is/are withdrawn from consideration.						
· ===	5) Claim(s) is/are allowed.						
•	6) Claim(s) is/are rejected.						
· —	7) Claim(s) is/are objected to. 8) Claim(s) <u>1-21</u> are subject to restriction and/or election requirement.						
8) <u> X</u> Clain	n(s) <u>1-21</u> are subject to restriction and/o	r erection requirement.					
Application Pa	apers			•			
<i>,</i> —	pecification is objected to by the Examir						
10) The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
·							
•	35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
a) All b) Some * c) None of:							
 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 							
 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage 							
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
Attachment(s)		, .	Cumman (DTO 442)				
	eferences Cited (PTO-892) raftsperson's Patent Drawing Review (PTO-948)	Paper	4) Interview Summary (PTO-413) Paper No(s)/Mail Date.				
3) Information Disclosure Statement(s) (PTO/SB/08)			of Informal Patent Application				
Paper No(s)	Paper No(s)/Mail Date 6) Uther:						

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DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-20, drawn to a biopsy punch, classified in class 606, subclass
 167.
 - II. Claim 21, drawn to a method of taking a biopsy of skin, classified in class128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case product as claimed can be used in a materially different process such as marking surgical sites on animal prior to surgery.
- 3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
- 4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

- 5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
- 6. This application contains claims directed to the following patentably distinct species: Species of figures 1 and 2; Species of figures 3 and 4; and Species of figures 5 and 6. The species are independent or distinct because they contain claims directed to distinct species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, some of the claims may be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

7. A telephone call was made to Matt Corr on 08/09/2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:00 PM..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin T. Truong Primary Examiner Art Unit 3734

ktt